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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/264,464 03/08/99 BLACH

E 12460.1-US-1

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EXAMINER

DAWSON, G

ART UNIT

PAPER NUMBER

3761

DATE MAILED:

04/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/264,464

Applicant(s)  
Blach et al

Examiner  
Glenn Dawson

Group Art Unit  
3761



☒ Responsive to communication(s) filed on Feb 1, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6,9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

GLENN K. DAWSON  
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9,12 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, there is no antecedent basis for "said first transverse axis".

In claim 8, there is no antecedent basis for "said surface ~~layers~~" and "said adhesive layers".

In claim 12, there is no antecedent basis for " said center longitudinal dimension".

In claim 19, there is no antecedent basis for "said first and second lateral regions of said bridge piece".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-4 and 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Muchin-5718224.

Muchin discloses in fig. 10b a nasal dilator having the claimed dimensions as it is basically oval in shape.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muchin-'224 in view of Johnson-'499.

Muchin discloses the invention substantially as claimed with the exception of the holes through the surface and adhesive layers and the multiple support members. As shown by Johnson, two lift members in a nasal support device were well-known at the time of the invention. It would have been an obvious design choice to have provided a plurality of the support members as this is a mere duplication of known parts.

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## DUPLICATION OF PARTS

In re Harza , 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water - tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies perpendicular to the workface and in the joint, and a plurality of "ribs" which are parallel to the workface, forming the following shape.

As for the holes, it was well-known at the time of the invention that Band-aids(adhesively affixed skin coverings) <sup>placed</sup> ~~to place~~ breathing holes through the surface and adhesive layers of the structure. It would have been obvious to have placed breathing holes through the surface and adhesive layers of Muchin's adhesively attached nasal dilator, as this has been shown to allow the skin under the adhesive patch to breathe.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitra et al- 5890486.

Mitra discloses the invention as claimed with the exception of the central bridge being integral with the side pieces. It would have been an obvious design choice to have separately made the three(3) main pieces of the nasal dilator of Mitra and then provided a well-known attachment means to attach them together on the face of the user as it was well known at the time of the invention that making integral parts separable was obvious.

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## MAKING SEPARABLE

In re Dulberg, 289 F.2d 522, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.").

It would be desirable to be able to remove and replace the various components of the device in the event that any of them lost their ability to stay adhesively attached to the skin, or in the event that a central bridge portion with a particular design thereon (as was known in the art) could be chosen to replace the bridge portions presently in use without having to replace all three elements.

As Velcro was a well-known attachment mechanism at the time of the invention, its use to attach the three components together would have been obvious.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected under the judicially created doctrine of double patenting over the claims of copending Application No. 09/018603. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a nasal support device having an adhesive layer and a support layer.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Response to Arguments***

Applicant's arguments filed 02-01-00 have been fully considered but they are not persuasive.

As pointed out in the Mitra 103 rejection, the examiner considers it obvious to make the integral dilator of Mitra into a modular system with separable components for the reasons noted above.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Glenn Dawson at telephone number (703) 308-4304. Examiner Dawson can normally be reached on Monday through Thursday from 7:00 AM to 5:30 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, examiner Dawson's supervisor, John Weiss, can be reached at (703) 308-2702. The fax number for Group 3300 is (703) 305-3590 or 3591.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 3300 receptionist at (703) 308-0858.

GKD  
April 19, 2000

GKD  
GLENN DAWSON  
PRIMARY EXAMINER